

AUG 03 2006

REMARKS

Favorable reconsideration is respectfully requested in light of the following comments.  
No new matter has been added as a result of this amendment.

Applicant respectfully requests that this amendment be entered and these comments be fully considered because after consideration thereof, the Application is believed to be in condition for allowance. Favorable reconsideration is therefore respectfully requested.

Rejection of Claims Under 35 USC § 103

The Office Action rejected claims 3 and 5-8 under 35 USC § 103(a) as being obvious over Umeya, U.S. Pat. No. 5,859,122 ("Umeya") in view of Ho et al, U.S. Pat. No. 6,607,831 ("Ho") and Anderson et al, U.S. Publ. No. 2003/0232222 ("Anderson"). Applicant respectfully traverses this rejection.

The third paragraph of the June 6 Final Office Action states that Umeya discloses a polycarbonate polyurethane resin composition that may be used as a paint, an adhesive, or a modifier for paper, wood, metal, FRP, FRTP, and other such materials. The Final Office Action also states that Applicant's claimed invention utilizes the polycarbonate polyurethane resin composition as a primer layer, which is placed between a plasticized polymer layer and an adhesive layer. Next, the Final Office Action asserts that "this is an obvious variation of the Umeya invention" (June 2 Final Office Action, page 3, third paragraph). The Final Office Action further asserts that the selection of the most appropriate base material would be within the realm of the ordinary practitioner of this art. The Final Office Action then creates an example of a bonded structure that utilizes a plastic cabinet base comprised of a plasticized polymer (page 4). Applicant respectfully asserts, based on the assertions presented in the June 6 Final Office Action and the other previously presented Office Actions, that a *prima facie* case of obviousness has not been established.

According to MPEP § 2142, three basic criteria must be met in order to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach

or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must **both** be found in the prior art (emphasis added).

Applicant respectfully asserts that a *prima facie* case of obviousness has not been established at least because, there is no suggestion or motivation to modify the reference or to combine reference teachings.

The Final Office Action states that the selection of the most appropriate base material would be within the realm of the ordinary practitioner in the art. Applicant does not necessarily disagree with this statement, but respectfully disagrees that the very specific choice of a plastic cabinet base comprised of a plasticized polymer was in any way suggested by or motivated by either the references or the knowledge generally available to one of ordinary skill in the art at the time of the invention.

Applicant asserts that neither Umeya, nor any combination of the cited references provide a suggestion or motivation to utilize Umeya's composition as a primer layer on a base material containing plasticizers, where the migration of the plasticizers is a concern.

Umeya's invention relates to a water-dispersable polycarbonate polyurethane resin composition which gives excellent oil resistance, solvent resistance, water resistance and abrasion resistance when used to treat various types of fibers, and which has a soft and resilient hand quality (Umeya, column 1, lines 7-12). It is further stated that it is an object of the invention that the compositions give a soft and resilient hand quality to fabrics treated therewith, which can be stable and reasonably produced, and which has excellent coatability under suitable aqueous dispersion conditions, as well as excellent water resistance, light fastness, heat resistance, oil resistance, and solvent resistance (Umeya, column 1, lines 59-67). The specific examples of "base materials" that are provided by Umeya include fibers such as woven fabrics and non woven fabrics, synthetic and artificial leather, and industrial materials (Umeya, column 5, lines 4-18). Based on the particular advantages provided by the compositions of Umeya, one of ordinary skill in the art would not have had any reason to think that those compositions would have any advantage if plasticizer migration was a concern.

Umeya does generically state that the polycarbonate polyurethane compositions can also be used as a paint, adhesive or modifier for paper, wood, metal materials, FRP, FRTP, and other such materials (Umeya, column 5, lines 19-23). Based on Umeya's general description of other types of materials that the polycarbonate polyurethane compositions of Umeya can be used on,

one of ordinary skill in the art would have been motivated to think that the use of such a composition may have advantages if properties such as oil resistance, solvent resistance, water resistance and abrasion resistance were at issue in any of these generally described materials. However, Umeya offers no disclosure, and no suggestion regarding anything related to plasticizers. Therefore, one of ordinary skill in the art would not have been motivated to utilize Umeya's compositions in a situation where plasticizer migration was an issue on materials other than fiber or any other material. Indeed, Umeya does not even offer any disclosure or suggestion about interactions between the material to be treated (i.e. fiber in Umeya) and any other overlying layer, it is entirely concerned with the properties of the treated fiber.

Neither Ho nor Anderson discloses or suggests that a polycarbonate polyurethane composition has any advantage, or even any use as a primer layer in multi-layer structures, and certainly do not provide any teaching of the very specific situation where plasticizer migration is a concern in a multi-layer structure.

Contrary to that, Applicant's specification (US 2005/0245674, paragraph [0005]) specifically discusses plasticizer resistance, and states that it means that a plasticizer contained in a base material is prevented from moving to the adhesive layer of an adhesive sheet. The importance of such a property is also discussed: if the plasticizer moves to the adhesive layer, the cohesive force of the adhesive layer is impaired. Such a decrease in the cohesive force induces a decrease in the adhesive force of the adhesive sheet with the base material and may cause the adhesive sheet to release from the bonded structure during use. Using this as a motivation to combine would constitute impermissible hindsight reconstruction.

Nothing within Umeya, or the knowledge of one of ordinary skill in the art would have motivated one of skill in the art to consider the compositions of Umeya to combat plasticizer migration from a base material to an adhesive layer.

MPEP § 2143.01 also states that neither the fact that references can be combined or modified nor the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is sufficient to establish *prima facie* obviousness.

Because the Final Office Action has failed to establish a *prima facie* case of obviousness, Applicant respectfully asserts that the rejection of claims 3 and 5-8 under 35 USC § 103(a) as being obvious over Umeya in view of Ho and Anderson must be withdrawn.

RECEIVED  
CENTRAL FAX CENTER  
AUG 03 2006

CONCLUSION

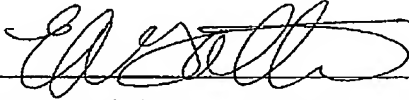
In view of the above, Applicant respectfully requests withdrawal of the rejection and allowance of the claims. Prompt passage to issue is earnestly solicited. Should the Examiner feel a telephone interview would be helpful in advancing this case to allowance, Applicant invites the Examiner to contact their representative at the number listed below.

Please continue to send all future correspondence for this matter to:

Colene H. Blank, Esq.  
Office of Intellectual Property Counsel  
3M Innovative Properties Company  
3M Center, P.O. Box 33427  
St. Paul, Minnesota 55133-3427

Respectfully submitted,

8-3-06  
Date

By:   
Elizabeth A. Gallo, Ph.D., Reg. No.: 51,716  
Telephone No.: 651-733-9608

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833